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Amendment and/or Response
Reply to the Office Action of June 30, 2004

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REMARKS/DISCUSSION OF ISSUES

Status of the Claims

Claims 18-26 and 28-29 are pending in the present application. Claims 1-17 and 27 have been cancelled without prejudice or disclaimer of their subject matter. Claim 18 is the independent claim under present consideration.

Rejections

1. Claims 21 and 22 have been rejected under 35 U.S.C. § 112, second paragraph. To wit, the Office Action asserts that there is insufficient antecedent basis for "sealed confronting surface." Applicants respectfully disagree. First, it is noted that claims 21 and 22 include the feature "...said sealed confronting surface..." (i.e., singular). Moreover, claim 18 clearly recites "...wherein said parallel confronting surface is sealed." Thus, claim 18 provides sufficient antecedent basis for the feature at issue. For at least the reasons set forth above, it is respectfully submitted that the present rejection is improper and should be withdrawn.

2. Claims 18-20 and 22-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Applicant's Prior Art Drawings* in view of *Eide* (U.S. Patent 5, 313,096). For the reasons set forth below, it is respectfully submitted that independent claim 18, and the claims that depend directly or indirectly therefrom are allowable over the applied references.

The establishment of a *prima facie* case of obviousness requires that *all* of the elements be found in the prior art. It follows, therefore, if a single element is not found in the prior art, a *prima facie* case of obviousness cannot properly be established. Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, suggestion or motivation to do so found in the references relied upon.

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However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability.

Claim 18 is drawn to a semiconductor device and includes the features:

*"...a semiconductor element having a circuit forming surface...;
a wiring disposed on said circuit forming surface and on a side surface of said semiconductor element;..."*

It is respectfully submitted that *Applicant's Prior Art Drawings* lacks a disclosure of at least the featured wiring as set forth in claim 18. To this end, the Office Action relies on element 604 from Fig. 21 of the filed application for the wiring that is disposed on the circuit forming surface. However, as plainly shown in Fig. 21, the element 604 is not disposed on a side surface of the semiconductor element.

In addition to the traversal of the rejection above, Applicants respectfully submit that the Office Action fails to meet the requirements of MPEP § 706, which states, inter alia:

"...The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity..."

To this end, the Office asserts that the reference to *Eide* discloses an "...outer electrode (60) contacting said wiring on said side surface of the semiconductor element (For Example: See Figure 2)."

The undersigned attorney has reviewed the reference to *Eide*, and has found that element 60 is an opening in Fig. 5. In addition to this discrepancy, the Office Action fails to set forth clearly those features relied upon in the reference to *Eide*. For example, the Office Action does not establish what wiring is contacting the outer

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electrode. Moreover, the Office Action relies on the disclosure of Fig. 21 of the filed application for the wiring 604. It is thus unclear from which piece of applied art the Office Action culls the teaching of a wiring. For at least the reasons set forth above, it is respectfully submitted that the Office Action dated June 30, 2004 fails to meet the minimum requirements of MPEP § 706.

Accordingly, for the reasons set forth above, it is respectfully submitted that prima facie case has not been properly established. Therefore, and while in no way conceding as to the propriety of the combination of references, it is respectfully submitted that independent claim 18, and the claims that depend directly or indirectly therefrom are allowable over the applied art. Allowance is earnestly solicited.

Conclusion

In view of the foregoing, applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Petition is hereby made for a one-month extension of time as provided under 37 C.F.R. § 1.136(a), extending the period of response from September 30, 2004 to November 1, 2004. Permission is hereby given to charge Deposit Account Number 50-0238 for the required fee under 37 C.F.R. § 1.17.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact William S. Francos, Esq. (Reg. No. 38,456) at (610) 375-3513 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account

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Number 50-0238 for any additional fees, including but not limited to, fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

Respectfully submitted on behalf of:
Oki Electric Industry Co. Ltd.



William S. Francos, Esq.
Reg. No. 38,456

Date: November 1, 2004

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